

**REMARKS**

Applicants respectfully request reconsideration and allowance of all pending claims.

**I. Status of the Claims**

Upon entry of this Amendment E, which accompanies Applicants' Request for Continued Examination, claims 34, 37, 38, 45-49 and 51-53 will be pending. Claims 39-44 are canceled in view of the Office's requirement for restriction. Applicants reserve the right to pursue these claims in one or more divisional applications.

Additionally, claim 34 has been amended to further define particular embodiments Applicants' invention, while claim 45 has been amended to correct a minor typographical error therein. Support for the amendment of claim 34 may be found in claim 46, as well as in paragraph [0015] of Applicants' published patent application. Accordingly, no new matter has been added by way of these amendments.

**II. Withdrawn/Canceled Claims**

Claims 39-44 are hereby canceled without prejudice or disclaimer.<sup>1</sup> Applicants reserve the right to pursue these claims in one or more divisional applications.

**III. Allowable Subject Matter**

Applicants acknowledge that claims 51-53 are allowed. Applicants also acknowledge that claims 47 and 48 are objected to as being dependent on a rejected base claim, but would be allowable if rewritten including all limitations of the rejected base claim. However, for the reasons set forth in detail below, Applicants respectfully submit that claims 47 and 48 are allowable as currently presented.

**IV. Rejection of Claims under 35 U.S.C. §112**

Claims 34, 45 and 47-49 are rejected under 35 U.S.C. §112, second paragraph, as failing to comply with the written description requirement and for being indefinite. In view of the

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<sup>1</sup> While Applicants still contend that withdrawal of these claims is improper, for the sake of brevity, the arguments presented in Applicants' Amendment C will not be repeated here.

amendments made herein, Applicants submit that these rejections are overcome, and respectfully request reconsideration thereof.

Both of the 35 U.S.C. §112, second paragraph rejections are based on independent claim 34 reciting ligands for two of the variables,  $X_1$ ,  $X_2$  and  $X_3$ , but being silent with respect to the third variable thereof. While Applicants believe that claim 34 as previously presented met the requirements for both written description and definiteness, as outlined in Applicants' previous response,<sup>2</sup> Applicants hereby amend independent claim 34 to now recite, in relevant part, that the third variable of  $X_1$ ,  $X_2$  and  $X_3$  is optionally selected from the group consisting of halogens, CO,  $NH_3$ , water, aromatic heterocycles, thioethers, and isocyanides.<sup>3</sup> Each of these recited ligands is fully supported by Applicants' specification, both in the structures of claim 46 and in paragraph [0015] of Applicants' published patent application (US2007/0071672).

In view of the foregoing, Applicants respectfully submit that the amendment to claim 34 presented herein overcomes the Office's written description and indefiniteness rejections. Applicants therefore request reconsideration and withdrawal thereof.

**V. Rejection of Claims under 35 U.S.C. § 103(a)**

Claims 34, 37, 38, 45, 46 and 49 are rejected under 35 U.S.C. § 103(a) as obvious over Zobi *et al.* (Inorg. Chem., 2003, Vol. 42, pages 2818-2820, published on Web 04/05/2003, hereinafter referred to as "Zobi"). The Office notes that "[b]ased on the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. § 102(e)." Applicants respectfully note that 35 U.S.C. § 102(e) applies only to (1) applications, published under § 122(b), by another filed in the US before the invention by the applicant, and (2) patents granted on an application for patent by another filed in the US before the invention by the applicant. Thus, Applicants believe the Office intended to cite Zobi, which is a journal article rather than an application for patent published under §122(b) or a patent, as prior art under 35 U.S.C. §§103(a)/102(a).

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<sup>2</sup> For the sake of brevity, the arguments presented in Applicants' Amendment D are not repeated here.

<sup>3</sup> In this regard it is to be noted that "optionally" simply refers to the fact if all three of the variables  $X_1$ ,  $X_2$  and  $X_3$  are not defined by the first markush group, then the third variable (i.e., one of  $X_1$ ,  $X_2$  and  $X_3$ ) is defined by the second markush group.

Under MPEP § 2132.01, Applicant's disclosure of his or her own work within the year before the application filing date cannot be used against him or her under 35 U.S.C. § 102(a). Further, under MPEP § 2132.01, an Applicant can rebut a *prima facie* 35 U.S.C. § 102(a) rejection, and thus a 35 U.S.C. § 103(a)/102(a) rejection, by submission of a specific declaration by the Applicants establishing that the article is describing their own work. (See, e.g., *In re Katz*, 687 F.2d 450, 215 USPQ 14 (CCPA 1982)).

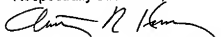
Applicants submit herewith a Declaration under 37 C.F.R. § 1.132 (*In re Katz*) of Dr. Roger Alberto and Dr. Fabio Zobi, stating that: (1) Drs. Alberto and Zobi are the sole inventors of methods and compounds claimed in this patent application; (2) Drs. Alberto and Zobi, along with Dr. Bernhard Spingler and Mr. Thomas Fox, co-authored the article cited by the Examiner; and, (3) Dr. Bernhard Spingler and Mr. Thomas Fox did not discover or invent the methods and compounds claimed in the present invention, nor did they make a conceptual contribution to the inventions claimed in the present application. Applicants submit that this declaration is sufficient to overcome the 103/102(a) rejection. Applicants therefore request reconsideration and withdrawal thereof.

#### CONCLUSION

In view of the foregoing, Applicant respectfully requests favorable reconsideration and allowance of all pending claims.

The Commissioner is hereby authorized to charge Deposit Account 13-1160 for any fees due for the submission of this Amendment E, including the fee for a one month extension of time as well as Applicants' Request for Continued Examination being filed simultaneously herewith.

Respectfully submitted,



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VIA EFS